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29 DEC 1999

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In re Application of
HIRITANI et al
Application No.: 09/242,046
PCT No.: PCT/JP96/02226
Int. Filing Date: 07 August 1996
Priority Date: None
Attorney Docket No.: 501.36894X00
For: SEMICONDUCTOR DEVICE AND ITS
MANUFACTURING METHOD

DECISION ON PETITION

This decision is in response to applicants' "SUPPLEMENTAL RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 USC 371" filed 29 July 1999 which is being treating as a petition to change an inventor's name under 37 CFR 1.182. The petition fee of \$130 has been charged to counsel's Deposit Account No. 01-2135, per applicants' authorization.

BACKGROUND

On 08 February 1998, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, inter alia: the basic national fee; an English-language translation of the international application; and a declaration and power of attorney of the inventors.

On 20 April 1999, the United States/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indication an oath or declaration and the surcharge for filing the oath or declaration later than 30 months from the priority date as required by 37 CFR 1.492(e) must be furnished. The notification set a one month time limit in which to respond.

On 29 July 1999, applicants filed the present papers stating that "the second listed inventor, Keiko Abdelghafar, signed the declaration in the above identified United States application with her correct name as of the time of signing on January 26, 1999. It was correctly stated that Ms. Keiko Abdelghafar's maiden name, which she used at the time of filing the international application, Keiko Kushida. However, in further studying this matter, it has been determined that Ms. Keiko Abdelghafar actually was married prior to the time of filing the international application, but chose to continue using her maiden (name) for matters concerning her employer, Hitachi, Ltd. (including patent applications) until 1998." These

statements have been construed to be a petition under 37 CFR 1.182 as discussed above.

DISCUSSION

The Manual of Patent Examining Procedure at § 605.04(c) requires in instances where an inventor has changed his or her name after the application has been filed to submit a petition under 37 CFR 1.182. The petition must include (1) the appropriate petition fee and (2) an affidavit signed with both names setting forth the procedure whereby the change of name was effected, or a certified copy of the court order. As noted above, the \$130 petition fee has been charged to counsel's Deposit Account No.01-2135, and thus item (1) has been satisfied.

With regards to item (2), applicants have not provided an affidavit signed with both names setting forth the procedure whereby the change of name was effected, or a certified copy of the court order. Therefore, item (2) has not been satisfied, and thus the petition may not be properly granted at this time.

CONCLUSION

For the reasons above, the petition is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.182." No additional petition fee is required.

A proper response must include an affidavit signed with both names setting forth the procedure whereby the change of name was effected, or a certified copy of the court order.

Extensions of time may be obtained under 37 CFR 1.136(a).

Failure to file a proper response within the period for response as set forth above, or as extended by any petitions for extensions of time under 37 CFR 1.136(a), will result in the abandonment of the application.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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